

REMARKS

Claims 1-59 are pending in the application. Claims 1-37, 40-43, 45-47, and 49-59 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0179902 to Ambrogio et al. Claims 44 and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ambrogio in view of U.S. Patent Application Publication No. 2003/0217267 to Kindberg. Claims 38 and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ambrogio in view of U.S. Patent Application Publication No. 2002/0178959 to Rennard.

Reconsideration is requested. The rejections are traversed. No new matter is added. The specification is amended to correct a typographical error. Claim 13 is amended to correct a typographical error. Claims 60-66 are added. Claims 1-66 remain in the case for consideration.

Support for new claims 60-66 can be found in the specification at, for example, page 12, lines 17-20, and page 13, line 26 through page 14, line 2. While the specification does not explicitly mention that a user can read the code with his eyes, the Applicant suggests this is inherent in the concept of the code being “readable”.

INTERVIEW SUMMARY

On April 23, 2008, the undersigned spoke with Examiner Bahta regarding the history of this application. The Examiner acknowledged that there had been delay on the Examiner’s part that led to the Applicant having to pay fees that should not have been necessary: namely, the fee for the Notice of Appeal filed on February 6, 2008.

REBUTTAL TO EXAMINER’S RESPONSE TO ARGUMENTS

In the Examiner’s Response to Arguments in the Final Office Action dated August 6, 2007, the Examiner states that the “Applicant argues that Ambrogio fails to disclose visible information. However, the claims do not specifically disclose whether the code has to be visible or invisible” (*see* Final Office Action dated August 6, 2007, page 14). Presumably, the Examiner makes this comment because Ambrogio does not teach visible codes, as argued previously. New claims 60-66 are added to explicitly recite that the code visible to the user.

The Applicant notes that the Examiner did not address the Applicant’s arguments with respect to claims 10, 32, and 53. Under M.P.E.P. § 707.07(f), “[w]here the applicant traverses

any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it". The Examiner's failure to address these arguments means that the Office Action is incomplete.

REJECTIONS UNDER 35 U.S.C. § 102(e)

The Examiner rejects claims 1-37, 40-43, 45-47, and 49-59 as being anticipated by Ambrogio. Ambrogio teaches generating a code, which is combined with a substantially invisible watermark, to connect the watermark to an object. The substantially invisible watermark is then attached to the object to allow tracking, tracing, and authentication of the object with the tracking system. A particular application of Ambrogio is the autograph memorabilia industry, to provide a way for people to be certain that a particular item is authentic.

A significant point in Ambrogio is the idea that the watermark be "substantially invisible" (*see, e.g.*, Ambrogio, ¶ 19). The reason why the watermark should be "substantially invisible" is obvious: in the autograph memorabilia industry, it is desirable that the memorabilia not be tainted by unnecessary, distracting, material. If the watermark is visible, this would lessen the value of the memorabilia object to the consumer. Thus, Ambrogio designed a system that is minimally intrusive in terms of including "unnecessary" added elements.

But if the watermark of Ambrogio is supposed to be "substantially invisible", then Ambrogio is directly teaching away from one of the features of the invention, which is to enable users to easily verify the authenticity of the object they are reviewing. In other words, Ambrogio specifically teaches doing something contrary to the spirit of the claimed invention.

There are other consequences in using a "substantially invisible" watermark as taught by Ambrogio. First, if the watermark is printed directly onto the object, the user might not be able to see the watermark. If the user cannot see the watermark, even if it is there, it is of no value to the user.

Second, even if the watermark is printed on a "non-removable" element attached to the object (*see, e.g.*, Ambrogio, ¶ 19), the same problem exists: the user might not see the watermark (for example, if it is printed on a label that has other, visible information). But even if the user knows there is a watermark, that does not enable the user to be able to access the system. After all, as the watermark is "substantially invisible", it would not be easily read by the user.

Third, because the watermark is “substantially invisible” and thus not easily read by the user, reading the watermark requires some specialized equipment. Ambrogio refers to “readers” (*see, e.g.*, Ambrogio, ¶ 21) as being responsible for scanning watermark and transmitting the data to the data center. In contrast, the claimed invention enables a user to determine information about the object without need of such specialized equipment: the user can simply input the code directly into a computer or other device that can interface with the database.

Thus, as the claimed invention is distinguishable from Ambrogio, the claims should be allowable over Ambrogio.

It is also worth noting that U.S. Provisional Patent Application Serial No. 60/345,858, filed January 4, 2002, and U.S. Provisional Patent Application Serial No. 60/362,807, filed March 8, 2002, from which Ambrogio claims priority (referred to hereafter as “the Ambrogio provisional patent applications”) both describe the watermark as “invisible”, not “substantially invisible”. While “substantially invisible” might mean that there is a possibility that a person might be able to detect the watermark with the naked eye, “invisible” without the modifier “substantially” suggests otherwise. This means that the idea of a watermark that might potentially be readable by the user was introduced in the Ambrogio regular patent application for the first time, and is not supported by the Ambrogio provisional patent applications. Accordingly, Ambrogio is not entitled to the benefit of the priority dates of the Ambrogio provisional patent applications, and should be accorded an effective filing date of January 6, 2003. As U.S. Provisional Patent Application Serial No. 60/398,432, filed July 24, 2002, from which this utility patent application claims priority, describes the code as being readable by the user (*see, e.g.*, provisional patent application specification, page 8, line 29 through page 9, line 18), the claimed invention has priority over Ambrogio. This means that Ambrogio is not proper prior art under 35 U.S.C. § 102 (and therefore not available under 35 U.S.C. § 103 either), and Ambrogio does not properly anticipate the features of the claimed invention.

Claim 4 is directed toward an apparatus according to claim 1, wherein the code generator is operative to generate base-35 codes.

Claim 5 is directed toward an apparatus according to claim 1, wherein the code generator is operative to generate alphanumeric codes.

Claim 19 is directed toward a method according to claim 14, wherein generating the code includes generating an alphanumeric code.

Claim 20 is directed toward a method according to claim 14, wherein generating the code includes generating a base-35 code.

Claim 45 is directed toward a method according to claim 36, wherein: receiving the code includes receiving an alphanumeric code; and the method further comprises converting the alphanumeric code to a machine-readable code.

Claims 4-5, 19-20 and 45 all recite either an alphanumeric code or a base-35 code. In rejecting claims 4-5 and 19-20, the Examiner cites to ¶¶ 16-17 of Ambrogio. ¶¶ 16-17 of Ambrogio do mention an alphanumeric code. But the Applicant suggests that Ambrogio does not properly anticipate the claimed invention.

Ambrogio claims priority from U.S. Provisional Patent Application No. 60/345,858, filed January 4, 2002, and U.S. Provisional Patent Application No. 60/362,807 filed March 8, 2002; Ambrogio was filed January 6, 2003 (“the Ambrogio provisional patent applications”). This patent application was filed July 21, 2003, and claims priority from U.S. Provisional Patent Application Serial No. 60/398,432, filed July 24, 2002. For Ambrogio to properly anticipate these claims, then either one of the Ambrogio provisional patent applications must teach the feature of an alphanumeric code or a base-35 code, or else the provisional patent application from which this application claims priority must not describe an alphanumeric code.

U.S. Provisional Patent Application Serial No. 60/398,432, filed July 24, 2002, from which this patent application claims priority, recites a base-35 code on page 2, line 6, on page 6, lines 26-27, and page 12, lines 31-34, which shows support for these claims in the provisional patent application dating back to July 24, 2002.

Unfortunately, Ambrogio provisional patent applications teach away from the concept of an alphanumeric or base-35 code. According to the Ambrogio provisional patent applications, the watermarks are produced by a firm called MediaSec. No other detail is given about the structure of this watermark. But the Ambrogio provisional patent applications state that the watermark is designed to be scanned: for example, using a web cam (*see, e.g.*, Pictures 3-4 of U.S. Provisional Patent Application No. 60/345,858, filed January 4, 2002). MediaSec, the firm described as being responsible for producing watermarks, does not suggest that alphanumeric watermarks are produced. Instead, MediaSec describes using a digital watermark technology, or

a two-dimensional bar code technology (*see, e.g.*, MediaSec - The Media Security Company, http://www.mediasec.com/html/en/products_services/index.htm, a copy of which was previously submitted). Such technology is compatible with a reader like a scanner, and shows that MediaSec teaches away from using an alphanumeric or base-35 code. Thus, the Ambrogio provisional patent applications teach away from using alphanumeric codes (which, if read by a scanner as shown, would require software to recognize the characters printed in the watermark: such character recognition is still less-than-ideal). Thus, the first effective discussion in Ambrogio of using alphanumeric codes in the watermark is in ¶ 16 of Ambrogio. This means that Ambrogio is not proper prior art under 35 U.S.C. § 102 (and therefore not available under 35 U.S.C. § 103 either), and Ambrogio does not properly anticipate the features of the claimed invention.

In rejecting claim 45, the Examiner cites to ¶ 6 of Ambrogio. ¶ 6 of Ambrogio does not mention anything about translating an alphanumeric code to a machine-readable code. The Applicant does not understand what the Examiner was saying in rejecting this claim.

Because Ambrogio teaches away from using alphanumeric codes before January 6, 2003 and this feature has an effective filing date of July 24, 2002, claims 4-5, 19-20, and 45 are patentable under 35 U.S.C. § 102(e) over Ambrogio. Accordingly, claim 4-5, 19-20, and 45 are allowable.

Claim 10 is directed toward an apparatus according to claim 9, wherein: the apparatus further comprises a notice indicating that the second code is not valid; and the transmitter is operative to transmit the notice if the second code does not match the first code.

Claim 32 is directed toward a method according to claim 28, further comprising, if the code is not associated with an object identifier, returning to the requester a notice that the code is not valid.

Claim 53 is directed toward a method according to claim 46, wherein receiving information from the computer includes receiving a notice from the computer that the code is not valid.

In rejecting claims 10, 32, and 53, the Examiner cites to ¶¶ 21-22 of Ambrogio. Nowhere in ¶¶ 21-22, or anywhere else, does Ambrogio mention a notice that a code is not valid. This makes sense in the context of Ambrogio: Ambrogio assumes that the watermark cannot be faked,

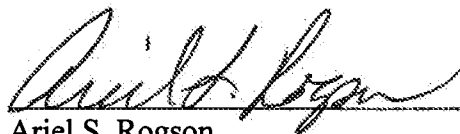
because of how the watermark is generated and placed on the object. But if the watermark cannot be faked, then every watermark is valid, and Ambrogio uses the watermark merely to access information known to valid. No such assumption is made in the claimed invention. In the claimed invention, it is possible that codes could be falsified. Detection of such falsified codes is accomplished based on the likelihood that the false code will almost certainly either not be recognized at all (in which case the notice of claims 10, 32, and 53 would be used), or would identify an unrelated object (in which case the notice of claims 10, 32, and 53 would not be used, but the information about the unrelated object would make it clear there was a problem with the code).

Because Ambrogio assumes watermarks cannot be faked, Ambrogio teaches away from the need for a notice that a code is not valid. Thus, claims 10, 32, and 53 are patentable under 35 U.S.C. § 102(e) over Ambrogio. Accordingly, claims 10, 32, and 53 are allowable, as are dependent claims 33-34 and 54.

For the foregoing reasons, reconsideration and allowance of claims 1-66 of the application as amended is requested. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

A handwritten signature in dark ink, appearing to read 'Ariel S. Rogson', is written over a horizontal line.

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